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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/020,521	12/14/2001	(Bruce) Yiqun Wang	1001.1465101	9132

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EXAMINER

BRUENJES, CHRISTOPHER P

ART UNIT	PAPER NUMBER
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1772

DATE MAILED: 09/30/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action

Application No.

10/020,521

Applicant(s)

WANG ET AL.

Examiner

Christopher P Bruenjes

Art Unit

1772

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 03 September 2004 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

- a) ☐ The period for reply expires _____ months from the mailing date of the final rejection.
- b) ☒ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on _____. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☐ The proposed amendment(s) will not be entered because:
- (a) ☐ they raise new issues that would require further consideration and/or search (see NOTE below);
 - (b) ☐ they raise the issue of new matter (see Note below);
 - (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
 - (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____

3. ☐ Applicant's reply has overcome the following rejection(s): _____.
4. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: see continuation sheet.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☐ will not be entered or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: none.Claim(s) objected to: none.Claim(s) rejected: 1,2,6-11 and 15-18.Claim(s) withdrawn from consideration: 19-21.

8. ☐ The drawing correction filed on _____ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____.
10. ☐ Other: _____

ADVISORY ACTION

Acknowledgement of Applicant's Response

1. Applicant's amendments filed September 3, 2004 have been entered since no changes have been made to the claims. The arguments presented in the remarks of the amendment have been fully considered but they are not persuasive as shown below.

REPEATED REJECTIONS

2. The 35 U.S.C. 103 rejections of claims 1-2, 6-11, and 15-18 over Ju in view of Muni and Jansen are repeated for the reasons previously of record in the Office Action mailed February 18, 2004, Pages 7-11 Paragraph 9.

ANSWERS TO APPLICANT'S ARGUMENTS

3. Applicant's arguments regarding the 35 U.S.C. 103 rejections of claims 1-2, 6-11, and 15-18 over Ju in view of Muni and Jansen have been fully considered but they are not persuasive.

In response to Applicant's argument that the rejection fails to establish a prima facie case of obviousness because of a lack of motivation, Muni et al and Jansen provide explicit motivation for adding nucleating agents to the pre-formed bend

Art Unit: 1772

of the catheter shaft. The examiner agrees that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either explicitly or implicitly in the references themselves or in the knowledge generally available to one of ordinary skill in the art. In this case, Muni explicitly teaches a motivation to change the crystallinity of portions of the catheter tube. The motivation is the following as presented in the first office action on the merits in this case.

Muni et al teach a catheter having at least two segments having different rigidities and other properties (see abstract). Muni et al further teach that catheters used in the vascular system are required to have a number of apparently conflicting physical characteristics. For example, the catheter must be sufficiently rigid in the proximal region to enable its distal end to be maneuvered by manipulation of its proximal end (col.1, 1.15-20). At the same time it is necessary for the catheter's distal end to be sufficiently soft so as not to traumatize the vascular walls when being advanced and sufficiently flexible to enable it to readily follow a potentially tortuous vascular path (col.1, 1.23-27). Muni et al teach that to create different rigidities in different segments of the catheter shaft without the use of a multi-piece structure (col.1, 1.45-55), as taught by Ju et al, selected portions or segments of the shaft are created with different crystalline structure. This variation in crystallinity imparts substantially varied physical properties to different portions of the same catheter, most notably providing for a substantial range in stiffness (col.2, 1.43-50). Furthermore, although increased polymerization results in a stiffer structure, more highly crystallized material can

Art Unit: 1772

be curved into a tighter radius without kinking (col.2, l.61-64). Muni et al further teaches that the crystallinity of the catheter may be varied in any of a plurality of zones throughout its length (col.4, l.20-22). One of ordinary skill in the art would have recognized that the crystallinity of the polymeric material forming the catheter shaft is varied in order to provide stiffer and more flexible segments of the catheter in order to balance the need for the catheter to be flexible so that it does not traumatize the vascular walls and yet sufficiently rigid in the proximal end to enable its distal end to be maneuvered by manipulation of the proximal end, as taught by Muni et al.

Jansen goes on to explicitly teach a motivation for using nucleating agents in the catheter of Ju and Muni combined in order to shorten the cooling times and lower the supercooling required to change the crystallinity desired by Ju and Muni taken as a whole.

The examiner admits the motivation of Muni to change the crystallinity and the motivation of Jansen to use add nucleating agents to the catheter to improve the process of changing the crystallinity taught by Muni are different than the motivation for adding nucleating agent to the catheter tube of the instant invention. However, the examiner points out that there is motivation to combine Ju, Muni, and Jansen as presented above and in previous office actions, only that the motivation is different than the motivation for adding the nucleating agents to the catheter tube in the instant invention.

Art Unit: 1772

Furthermore, the reason or motivation to modify the reference may often suggest what the inventor has done, but for a different purpose or to solve a different problem. It is not necessary that the prior art suggest the combination to achieve the same advantage or result discovered by applicant. Also, although obviousness cannot be established by combining references "without also providing evidence of the motivating force with which would impel one skilled in the art to do what the patent application has done", reading the quotation in context it is clear that while there must be motivation to make the claimed invention, there is no requirement that the prior art provide the same reason as the applicant to make the claimed invention. See MPEP 2144.

Conclusion

4. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Christopher P Bruenjes whose telephone number is 571-272-1489. The examiner can normally be reached on Monday thru Friday from 8:00am-4:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Harold Pyon can be reached on 571-272-1498. The fax phone number for the

Art Unit: 1772

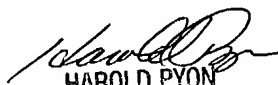
organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Christopher P Bruenjes
Examiner
Art Unit 1772

CPB

September 17, 2004


HAROLD PYON
SUPERVISORY PATENT EXAMINER 9/17/04
1772